



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,336	10/29/2001	Robert Setbacken	8371/9	1535

7590

03/19/2003

John C Freeman
Brinks Hofer Gilson & Lione
PO Box 10395
Chicago, IL 60610

EXAMINER

LE, QUE TAN

ART UNIT

PAPER NUMBER

2878

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,336

Applicant(s)

SETBACKEN ET AL.

Examiner

Que T. Le

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 24 February 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

This is in response to Applicants' amendment filed February 24, 2003.

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error, which is relied upon to support the reissue application.

See 37 CFR 1.175(a)(1) and MPEP § 1414.

Applicants fail to identify, in the reissue declaration, at least one specific error, in the specification and/or in at least one of original claims, and how it renders the original patent wholly or partially inoperative or invalid. 37 CFR 1.175(a)(1) and MPEP Section 1414 state that "In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid." Further, it is required that any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. Applicants, in the reissue declaration, fails to provide an identification of such at least one specific error and its relation to the wholly or partly inoperative or invalid of the patent. Thus, it is to confirm that the reissue oath/declaration, filed 10/29/01, and the Supplemental reissue oath/declaration, filed 2/24/03; both fail to include the above-required identification (of at least one specific error).

Claims 1-38 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

The amendment filed February 24, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The newly insertion of "As shown in Fig. 1, the exterior thread 12 is inserted into an opening 106 that is formed, at least in part by the clamping element 104" into column 2 contains new matter. Before the above-mentioned amendment, the particular insertion/inserting operation/performance of the exterior thread (of the screw 11) into the opening 106 (of the clamping element) has never been discussed or described throughout the disclosure of the invention. The only operation/performance, which has been disclosed and discussed throughout the disclosure of the invention, of the screw (11) and/or its (exterior) thread (12) in relation to the clamping device and/or the interior thread (8) of the opening of the clamping device, is that "the screw 11 is turned into the hollow pick-up shaft 2" (column 2, lines 60-61); "the screw 11 can be further turned with relation to the pick-up shaft" (column 2, lines (66-67); "the screw 11 has been turned into the pick-up shaft 2" (column 3, line 26); "the screw 11 can be turned into the pick-up shaft 2" (column 4, line 1). The exact manner in which the clamping operation/performance achieved by the relative turned movement between the screw 11 with exterior thread and the clamping device with interior thread (of the pick-up shaft 2) has been clearly disclosed and discussed by the originally filed specification. The originally filed specification specifically requires and states that the invention comprises "a screw being the actuating element which can be turned in the pick-up shaft" in which a must

Art Unit: 2878

inclusion of the screw with an exterior thread (in the clamping area) and the pick-up shaft with a corresponding interior thread is required in order to achieve a clamping operation, fixed against relative rotation between the pick-up shaft and the drive shaft. Nowhere whatsoever the specification, of the originally filed disclosure of the invention, has ever disclosed or discussed a simple insertion operation or inserting movement of an actuating element into an opening or slit of the clamping element or into a corresponding element which engages a pick-up shaft and a drive shaft (so as to be fixed against relative rotation). The above-mentioned amendment to the specification, thus, contains new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19 and 25-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. A proper support for the citation of "a clamping element comprising ... an opening in which said actuating element is inserted, wherein movement of said actuating element with respect to said slit causes said slit to radially spread open ... relative rotation" on lines 4-8, of claim 19, has not been found in the present specification. The originally filed specification and its

Art Unit: 2878

claimed invention (claims 1-4) have never disclosed an actuating element which merely be inserted into an opening (of a clamping element), wherein the movement of said actuating element causes the slit to radially spread open. The originally filed specification and its claimed invention, claims 1-4, comprises and/or calls for "a screw being the actuating element (with an exterior thread in the clamping area) which can be turned in (a corresponding interior thread on) the pick-up shaft. Thus, the specification, at the time the application was filed, had no possession of the claimed invention as now being claimed.

Claims 19 and 25-29 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

Claims 19 and 25-29 contain the features of "an actuating element" which simply be inserted into an opening of a clamping element having a slit in which the (inserting) movement of the actuating element causes the slit to radially spread open, which are considered new matter for the reasons set forth above.

Applicant's arguments filed February 24, 2003 have been fully considered but they are not persuasive.

With respect to Applicants' arguments, on pages 4-5 and 7 of the remarks, in which applicants insist that applicants have recited at least one recognized error from which a reissue application can be based, this is found not persuasive because the recited error does not meet the specific requirement set forth by the 37 CFR 1.175(a)(1)

Art Unit: 2878

and MPEP Section 1414 stated above. Applicants fail to identify at least one error in which the at least one error must be identified by at least a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid.

With respect to Applicants' arguments, on pages 5-6 and 7-8, of the remarks, regarding the 35 U.S.C. 112, first paragraph and new matter rejection, respectively, the arguments is not persuasive because applicants fail to prove anywhere, in the originally filed disclosure of the invention, disclose or discuss the feature of a mere insertion or being inserted of an actuating element or screw into an opening of a clamping element. It is agreed that at least Fig. 1 and the discussion on column 2 shows and teaches that the screw 11 includes an exterior thread and the slit 7 of the clamping element 104 includes an interior thread wherein the operation/performance of the screw by a "move via a turning motion" (applicants admitted statement on page 6 of the remarks) which then causes the slits to radially spread open. It is known to one of ordinary skill in the art and thus, showing by at least Fig. 1, that when a screw with a move "via a turning motion" into a corresponding element must inherently include at least an exterior thread (of the screw) and the corresponding element may include an interior thread. The operation/performance by "insertion" or "inserting" movement (of an actuating element) and the operation/performance by "turned in" or "being turned" movement (of a screw) are unarguable different operation/performances. It is a clearly and obvious evidence that the claimed invention, in light of its specification, of the originally filed disclosure, is patentably different from the prior art of record (See reasons for allowance by the

Art Unit: 2878

examiner in paper no.6 of the originally filed Patent application serial no. 08/929,539, now corresponding U.S. Patent no. 5,981,940) because the claimed invention requires a screw being an actuating element (which has an exterior thread) which can be turned in (a corresponding interior thread on) the pick-up shaft. Also, as being admitted by applicants, on page 8 of the remarks, the claimed invention and its corresponding specification, as newly submitted, not only include a requirement of a screw being an actuating element with an exterior thread which can be turned in (a corresponding interior thread on) an opening or slit (of a clamping element) but should also "covering the situation where mere insertion of an actuating element causes a slit to radially spread open". Firstly, the originally filed specification never disclose "an insertion movement of the screw being an actuating element", hence, applicants fail to provide a proper support for the amendment(s) filed in this reissue patent application. Secondly, applicants has failed to prove that the originally filed disclosure discloses a specific operation/performances of the movement performed by a mere insertion (of an actuating element) into an opening or slit of a clamping element or a corresponding which causes the slit to radially spread open, and has admitted that the intended scope of the now claimed invention is being changed by the inclusion of (page 8 of the remarks) a new and different "situation where mere insertion of an actuating element causes a slit to radially spread open". Thus, the submitted amendment(s) contains new matter.


Accordingly, the rejection set forth above is proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Que T. Le whose telephone number is (703) 308-4830.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Que T Le
Primary Examiner
Art Unit 2878